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IN THE

Supreme Court of the United States

ERIC ELDRED, et al., *Petitioners*,
v.
JOHN D. ASHCROFT, IN HIS OFFICIAL CAPACITY AS ATTORNEY GENERAL, *Respondent*.

On Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

BRIEF OF COLLEGE ART ASSOCIATION, VISUAL RESOURCES ASSOCIATION, NATIONAL HUMANITIES ALLIANCE, CONSORTIUM OF COLLEGE AND UNIVERSITY MEDIA CENTERS AND NATIONAL INITIATIVE FOR A NETWORKED CULTURAL HERITAGE AS *AMICI CURIAE* IN SUPPORT OF PETITIONERS

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QUESTIONS PRESENTED

Did the United States Court of Appeals for the District of Columbia Circuit err in holding that Congress has the power under the Copyright Clause to extend retrospectively the term of existing copyrights?

Is a law that extends the term of existing and future copyrights "categorically immune from challenge[] under the First Amendment"?

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Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990) 15
Jessica Litman, *Reforming Information Law in* Copyright's Image, 22 U. DAYTON L. REV. 587 (1997) 15
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INTEREST OF THE *AMICI CURIAE*[1]

The College Art Association (CAA) is a membership organization representing 14,000 artists, art historians, scholars, curators, collectors, educators, art publishers and other visual arts professionals who, by vocation or avocation, are concerned about and are committed to the practice of art, teaching and research about the visual arts and humanities. Another 2,000 university art and art history departments, museums, libraries and professional and commercial organizations are institutional members of CAA.

The Visual Resources Association (VRA) is a professional society with more than 600 members devoted to advancing knowledge, research and education in the field of visual information research. The Association offers a forum for issues surrounding documentation and access to images of visual culture, integration of technology-based instruction and research, intellectual property policy and visual information standards development. Members include art, architecture, film and video librarians; image specialists, including slide, photograph, microfilm and digital archivists; museum curators; galleries; publishers; image system vendors; rights and reproduction officials; photographers; art historians; artists; and scientists. The majority of the VRA membership represents visual resources professionals and librarians working in higher education and museums, managing visual collections of 35mm slides, photographs and digital images to support education and research.

The National Humanities Alliance (NHA) is a coalition of more than eighty associations concerned with national humanities policy. Membership includes associations of scholars and scholarly societies, libraries, museums, state

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[1] Letters from all parties consenting to the filing of this brief have been filed with the Clerk of this Court. No counsel for a party authored this brief in whole or in part, and no person other than *amici curiae*, or their counsel, made a monetary contribution to the preparation or submission of this brief.

humanities councils, historical societies, institutions of higher education, independent and university-based research centers and university presses. The NHA advocates for support for humanities research and represents its members in matters of policy or legislation affecting work in the humanities.

The Consortium of College and University Media Centers (CCUMC) is an organization whose mission is to provide leadership and a forum for information exchange to the providers of media and technology support for quality teaching and learning at higher education institutions. The more than 650 members represent all sizes of institutions in higher education that provide media and instructional technology-related support services, as well as companies providing related products.

The National Initiative for a Networked Cultural Heritage (NINCH) is a diverse nonprofit coalition of arts, humanities and social science organizations created to assure leadership from the cultural community in the evolution of the digital environment.

SUMMARY OF THE ARGUMENT

Amici's members use, preserve, study, teach, publicly display, publicly perform and create derivative works from works affected by the Copyright Term Extension Act (CTEA). The Act's most immediate prohibitory effects on these activities involve works that were in their second term in 1978 or were works for hire. *See* 17 U.S.C. §§ 302(c), 304(b). Absent the CTEA, significant numbers of these works would have fallen into the public domain within the next few years, making them freely available for a broad range of scholarly, creative and educational purposes. The CTEA applies retrospectively, extending the terms of these subsisting copyrights by twenty years. This term extension especially penalizes scholars, museums, teachers and artists – *amici*'s members – whose work centers around works of the past: They have been deprived of their ability to use these works without risking suit for infringement for at least twenty additional years.

That *amici*'s members either may rely on the fair use provisions of the Copyright Act or wait two decades from now to have the unfettered right to use these works is no palliative. Fair use, which in theory is available to mitigate the substantial restraints that copyright imposes on free speech, is in practice unpredictable and uncertain – especially for uses of images and in published work. The direct result of the CTEA is that *amici*'s members are forced to self-censor their speech with respect to works that otherwise would be in the public domain.

As *amici*'s members experience daily, retrospective term extension directly restricts expression. Therefore, it must be evaluated under the exacting standards set forth in *Turner Broadcasting System, Inc. v. Federal Communications Commission*, 512 U.S. 622 (1994) (*Turner I*) and *Turner Broadcasting System, Inc. v. Federal Communications Commission*, 520 U.S. 180 (1997) (*Turner II*). As the *Turner* cases reaffirmed, content-neutral regulations of speech are constitutional only if they further a substantial governmental interest unrelated to the suppression of free expression and restrict no more speech than necessary.

Retrospective term extension miserably fails *Turner* scrutiny: The evidence before Congress demonstrated that there could be no justification for extending subsisting copyrights, other than to add an extra twenty years of potential revenue to the relatively small number of works that had proved enduringly successful. This subsidization of a few works of a few copyright owners – who already have received significant value from their ownership under the preexisting term – is not narrowly tailored and cannot justify the widespread suppression of speech that is the inevitable and demonstrable consequence of the CTEA. As a result, prospective term extension further tips the copyright balance away from legitimate expressive use of copyrighted works.

ARGUMENT

I. Retrospective Term Extension Severely Inhibits a Wide Range of Expression in Ways That Congress Failed To Consider.

Amici's members use copyrighted expression to teach, to incorporate into scholarship or art, and to express a thought in the most persuasive way, all of which is core First Amendment speech.[2] For their purposes, there often is no substitute for the full image of a work of art or a photograph. The Court has recognized that images in particular may have visceral impact that text cannot convey. *See Texas v. Johnson*, 491 U.S. 397, 405 (1989) ("The use of an emblem or flag to symbolize some system, idea, institution, or personality, is a short cut from mind to mind.") (quoting *West Virginia Bd. of Educ. v. Barnette*, 319 U.S. 624, 632 (1943)); *Regan v. Time, Inc.*, 468 U.S. 641, 678 (1984) (Brennan, J., concurring and dissenting in part) ("The adage that 'one picture is worth a thousand words' reflects the common-sense understanding that illustrations are an extremely important form of expression for which there is no genuine substitute."). *Amici*'s members also use literary works, music and other materials. Their ability to demonstrate and persuade depends on their showing readers, viewers and students what they are talking about – in short, it depends on their ability to copy, display or perform copyrighted works.

Retrospective term extension limits this type of speech in a multiplicity of ways. Congress considered none of them.

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[2] A scholar's or artist's choice of what speech to reproduce or endorse is subject to the highest constitutional protection. "Selecting which speech [to copy and distribute] is, as we know from the example of publishing houses, movie theaters, bookstores, and Reader's Digest, no less communication than is creating the speech in the first place." *Turner I*, 512 U.S. at 675 (O'Connor, J., concurring and dissenting in part); *see also Hedges v. Wauconda Cmty. Unit Sch. Dist. No. 118*, 9 F.3d 1295, 1302 (7th Cir. 1993) ("A city may not limit booksellers to vending the works they write themselves . . . . That adopting the expression of others is a form of speech we freely concede.").

In *Turner I*, the Court noted that the record before it lacked findings on the effects of the regulation on the "losers" – the cable operators whose speech was suppressed in order to promote the speech of local broadcasters. 512 U.S. at 667-68. Without that information, essential to evaluating whether the regulation was narrowly tailored, reversal and remand was required.

When it enacted the CTEA, Congress repeated that mistake: It did not balance the possible advantages of retrospective term extension to owners of older lucrative copyrights against the harms to the freedom of all the other speakers – such as the art historians, scholars and artists – whose work is studying the past. Congress did not, as the First Amendment requires, make a reasoned judgment that the "burden imposed" on speakers was "congruent to the benefits [the retrospective term extension] affords," *Turner II*, 520 U.S. at 215. Its failure to do so, in and of itself, is a basis for reversing the judgment of the Court of Appeals.

A. Retrospective Term Extension Substantially Inhibits Scholarship, Teaching and Creativity.

In the past, researchers could anticipate and plan on new material becoming available for unrestricted use on a constant and continuing basis. Retrospective term extension, however, "puts a 20-year moratorium on the public domain" and completely upsets those expectations. Minority Views of Sen. Brown, S. Rep. No. 104-315 (July 10, 1996). It makes use of older works impossible – or nearly so – in many instances. Because *amici*'s members need to use such works, but are unable to rely on fair use for much of their most important expression, *see infra* Section I.B, they must obtain permission for each use. That permission, however, can often be impossible to obtain.

To begin, scholars and researchers have immense difficulties even finding successors in interest to the copyright owners of many decades past. *Amici*'s members routinely engage in expensive, time-consuming and often fruitless searches for the copyright owners of these older works. The process often begins with genealogy –

attempting to determine the author's heirs – and ends at the telephone book.[3]

The problem is multiplied for institutions with substantial collections. The Memorial Art Gallery in Rochester, New York wished to reproduce works it owns in publications, as in slide sets for local area teachers as part of educational programs, or on the Internet for other teachers. It has difficulty, however, finding copyright owners for works many decades after their creation. *Cf. Reno v. American Civil Liberties Union*, 521 U.S. 844, 876-77, 881-82 (1997) (law making it "prohibitively expensive" or economically infeasible to determine when speech was lawful unconstitutionally restricted speech).

Moreover, the extraordinary costs in time, energy and money needed to engage in a search for a copyright owner frequently deters would-be speakers from doing so. On their side, copyright owners may refuse permission simply because their transaction costs are too high – the administrative costs involved outweigh the small fees that the copyright owner might recoup. As a result of retrospective term extension, all of these difficulties now persist for another twenty years and, as the date of original authorship recedes ever further in time, they are significantly exacerbated.

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[3] *See, e.g., The Copyright Term Extension Act of 1995, Hearing on S. 483 Before the Senate Comm. on the Judiciary*, 104th Cong. 42 (Sept. 20, 1995) [hereinafter *1995 Hearing*], at 18 (Statement of Marybeth Peters, Register of Copyrights [hereinafter Peters]):

> [I]t is exceedingly difficult to determine the copyright status of certain types of works, e.g., photographs, prints and labels. Moreover, finding the current owner can be almost impossible. Where the copyright registration records show that the author is the owner finding a current address or the appropriate heir is extremely difficult. Where the original owner was a corporation, the task is somewhat easier but here too there are many assignments and occasionally bankruptcies with no clear title to works.

This inability to clear rights to older works has enormous practical consequences for scholars, teachers and artists, none of which were explored by Congress. For example, "Who Built America?" is a pathbreaking, award-winning CD-ROM series containing many primary sources from the Depression Era for high school and college students. Its authors had immense difficulties tracking down copyright owners, who, when found, sometimes wanted large payments for older works whose only present value was historical. In numerous instances, the authors substituted federal government works and other public domain works for their preferred choices.[4] The authors were forced to leave out works entirely – Huey Long's 1935 campaign song, "Every Man a King," as well as brief excerpts from popular films of the time, for example – because copyright owners insisted upon thousands of dollars for minor uses. In other cases, such as excerpts from *Cane*, the 1923 novel by well-known Harlem Renaissance author Jean Toomer, they invested months of effort and hundreds of dollars in acquiring permissions, draining their limited budget and time.

Amici's members overwhelmingly report that this experience is typical. Permission fees for single images, short excerpts and other short works routinely run into the hundreds of dollars, if they are available at all. To take another example, "The Video Encyclopedia of the Twentieth Century," a resource used by CCUMC members and other

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[4] Likewise, Thomas Thurston of Teachers College at Columbia University, Project Director of the New Deal Network, has found that the bulk of primary documents available via popular digital sources, including the New Deal Network, emphasize government over society. These online and easily accessible materials are becoming the raw materials used by high school teachers and others to teach the history of the 1920s and 1930s. The New Deal Network, for example, offers primary sources, lesson plans, web projects and bibliographic materials on the Great Depression. Absent Disney, Warner Brothers and Gershwin, the New Deal being represented digitally appears to play a far greater role in American culture of the period than it actually did.

higher education institutions, makes enormously valuable documentary footage available to scholars and students. Difficulties in rights-clearance, however, have left gaping holes in this resource.

Copyright owners also have been known to refuse permission for scholarly works because they disagree with the content.[5] Julia Foulkes, a cultural historian at the New School University, for example, was denied permission to quote letters from a dancer in her book on the development of modern dance in the 1930s and 1940s on the basis of what the copyright owner deemed Foulkes' "race/gender agenda." Professor Jonathan Fineberg of the University of Illinois, a longtime CAA member and a past member of its Board of Directors, wanted to use a photograph of Picasso watching his daughter draw in his well-known book *The Innocent Eye: Children's Art and the Modern Artist* (Princeton Univ. Press 1997). The photograph was the most important documentation for Professor Fineberg's argument about Picasso's use of his children's drawings in his own work. The copyright owner disagreed with the interpretation and refused permission. Two publishers declined to chance a fair use defense. Ultimately, Professor Fineberg was forced to abandon the photograph, weakening and censoring his argument.[6]

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[5] Copyright claims that are motivated by disagreement with a defendant's message have, in some cases, advanced to appellate litigation. *See, e.g., Religious Tech. Ctr. v. Scott*, 82 F.3d 423 (9th Cir. 1996) (one of a large number of copyright cases brought by Church of Scientology against critics); *Maxtone-Graham v. Burtchaell*, 803 F.2d 1253 (2d Cir. 1986) ("pro-choice" author sued Catholic priest for copyright infringement). Although the defendants in these cases ultimately prevailed, that they were litigated, at great time and expense, to the court of appeals level simply underscores the tremendous risks run by scholars and publishers who want to rely on fair use. *See infra* Section I.B.

[6] *See also, e.g., Hearings on H.R. 989 Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 104th Cong. (statement of Dennis Karjala, Professor of Law, Arizona State University [hereinafter Karjala *House Statement*]), reproduced in *1995 Hearing, supra*, at 83 n.8 (discussing refusals by estate of Lorenz Hart to allow any biographer who mentions Hart's homosexuality to use Hart's lyrics and Sylvia Plath's husband's exercise of editorial control over biographers).

Other copyright owners simply refuse permission outright. Paul Lauter, the general editor of the Heath Anthology of American Literature and editor of the New Riverside Series of critical editions of classic works (now published by Houghton Mifflin), has been denied permission to use numerous works that would now or soon have been in the public domain absent retrospective term extension. The owner of Ernest Hemingway's copyrights, for example, refuses to allow any anthology to use more than one Hemingway story of any length.[7] This includes stories from *In Our Time*, which was about to come into the public domain before the CTEA. The New Riverside Series had been planning an analytical edition of *In Our Time*, containing additional materials to aid contemporary students in understanding Hemingway's context, but the CTEA's retrospective term extension forced cancellation of those plans. As a result, the only available edition of the book has no notes or commentary.

The New Riverside Series had planned a critical edition of Jean Toomer's *Cane*. The only available edition is outdated and edited by a person who dislikes Toomer. The CTEA now prevents the New Riverside Series from presenting a contrary perspective. Given the current costs of books and limited student budgets, anthologies and critical editions with commentary are essential resources for teaching. Yet even when a publisher is willing to pay, as Houghton Mifflin is, it is often barred from making older works accessible to readers.

Artists and other creators who wish to use older works as part of, or as a starting point for, new works of art also face often insurmountable barriers to doing so. Artists face particular risks in that copyright owners are likely to deny

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[7] The same owner controls F. Scott Fitzgerald's works and allows only a certain number of Fitzgerald's words to be used.

permission to use or "quote" artistically based on their opinions about art and the original artist's reputation. This occurs even though copyright law, in theory, recognizes that owners' interest in reputation should not control commentary on a work, whether the commentary is academic or takes the form of a creative response (such as Marcel Duchamp's famous addition of a mustache to a picture of the Mona Lisa).

Retrospective term extension suppresses artists' creation of new and insightful derivative works. For example, a public art competition is seeking murals for Queens Plaza Station in Long Island City, New York, a subway stop located near the Queens branch of the Museum of Modern Art. Ellen K. Levy, a member of the CAA Board of Directors and a CAA Vice President, and Grace Graupe-Pillard, two artists, are proposing a mural using figures taken from famous artworks by Jacob Lawrence, Henri Matisse, Reginald Marsh, Frida Kahlo and Henri Rousseau. Some of these works are still within copyright as a result of retrospective term extension. The figures would "step out" from their frames to become fellow subway travelers, joining the bustling world outside, depicting a metaphoric journey of converging paths, goals and aspirations. The proposed mural's artistic merit, however, may be outweighed by a difficult or expensive clearance process or a threat of suit over works that would have been in the public domain but for the CTEA.

In another instance, Scott Andrew Hutchins, a writer, wrote a novel, *Tip of Oz*, using characters from the *Oz* series begun by L. Frank Baum. Though over twenty of the forty books in the *Oz* series are in the public domain, one significant plot element of Hutchins's book depends on reference to events in a book that would have fallen into the public domain in 2001 absent the CTEA. The copyright owner refuses to authorize any uses of Baum's characters other than in the International Wizard of Oz Club short story annual. Hutchins is prohibited from publishing his novel.

But for the CTEA, the silent films of the 1920s and 1930s would also have offered substantial opportunities for new expression. Such films used to be accompanied by live musicians. Modern composers have written new scores for them, such as Richard Einhorn's *Voices of Light*, the much-praised work created to accompany the famous 1928 French film *The Passion of Joan of Arc*. Many, however, have been forced to abandon such projects due to the risks of publicly performing older films. *See also* Minority Views of Sen. Kohl, S. Rep. No. 104-315 (July 10, 1996) (noting that great American musicals go unperformed because regional theaters cannot afford licensing fees).

Relatedly, works about art and artists are increasingly difficult to create. Davis Publications, a publisher of numerous art books and student textbooks, often encounters difficulty obtaining permission to print images, including, for example, works owned by the Georgia O'Keeffe Foundation, many of which date from the 1920s and 1930s. Davis has been forced to switch images due to the expense or difficulty of obtaining permissions, thus engaging in deliberate self-censorship.

Scholarly research and teaching have a special place in First Amendment law; scholarship embodies the spirit of free inquiry at the heart of the First Amendment. *Sweezy v. New Hampshire*, 354 U.S. 234, 250 (1957). Professors and teachers also provide students with the knowledge that can empower them as educated citizens, if they are allowed to do so. *Board of Educ., Island Trees Union Free School Dist. No. 26 v. Pico*, 457 U.S. 853, 868 (1982) (students' right to receive broad range of information and ideas is corollary of First Amendment rights of free speech and press). Art, too, provides unique benefits, illuminating the human condition and expressing thoughts more vividly than otherwise possible. Retrospective term extension substantially undermines the First Amendment value of these endeavors by requiring permissions and clearances, where the public domain would have promoted the interests in expression.

B. Fair Use Is Insufficient To Protect the First Amendment Interests at Stake.

Congress did not consider whether the availability of the fair use doctrine might mitigate the harms caused by retrospective term extension. Uses for scholarship, art and teaching are, of course, at the core of the affirmative defense of fair use afforded by section 107 of the Copyright Act, 17 U.S.C. § 107, particularly when the work at issue is old and lacks present economic value.[8] Indisputably, *amici*'s members rely on the fair use doctrine in many of their activities. Yet the theoretical applicability of the doctrine does not avoid the constitutional infirmities of retrospective term extension, due largely to the widely recognized uncertainties surrounding the availability and application of the doctrine in practice.[9]

The fair use doctrine fails to give publishers the assurance they need that they can publish without

[8] Nonetheless, it is worth noting that any speech that is sold or advertiser-supported is deemed "commercial" and thus less favored under the fair use analysis. As a result, most of the entities with the ability to disseminate speech, including academic publishers, start off with a strike against them. Although First Amendment law limits "commerciality" to speech that proposes a commercial transaction, the law of fair use has no such limit. The situation with regard to images is even worse. In many cases, *amici*'s members need to use all or substantially all of an image, which translates into another strike against them because applying the fair use doctrine also requires consideration of the amount of the original work used. 17 U.S.C. § 107(3).

[9] Even in the academy, there are no clear fair use parameters. Guidelines negotiated by universities and copyright owners provide only minimum standards above which certain copying for classroom use may or may not be fair use, leaving staff and administrators at risk of liability. *See Agreement on Guidelines for Classroom Copying in Not-For-Profit Educational Institutions*, H.R. REP. NO. 94-1476, 94th Cong., at 68-70 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5681-83. The Guidelines do not address public display or performance, or use in scholarly works. Likewise, 17 U.S.C. § 110(2), permitting limited transmissions for in-classroom use, does not cover modern, digital distance education. *See* Register of Copyrights, Report on Copyright and Digital Distance Education iii, vii-viii, 144-45 (May 1999).

interference. For instance, Jeff Clark, chair of CCUMC's Government Regulations and Public Policy Committee and Director of Media Resources at James Madison University, surveyed the submission guidelines of a selection of long-established American film study journals and found that most will not publish film frames without express permissions. Furthermore, permission clearance and payment is most often left to the scholar. Other fora for displaying, distributing or performing works express the same concerns. Their routine insistence on clearances from copyright owners inevitably results in self-censorship when clearance is unobtainable.

Examples of such self-censorship by *amici*'s members are legion. Dr. Kate Sampsell, for example, has written *"To Grab a Hunk of Lightning": An Intellectual History of Depression-Era American Photography*, a dissertation that will be published as a book. She has been attempting, with no success, to track down copyright owners of documents supporting a 1932 book, which exposed the horrors of the chain gang for African Americans in Georgia. The repository holding these materials will not allow her to have copies of written materials and images even for her own use, much less for publication. Some of the materials, in fact, were taken from the Georgia Bureau of Prisons, which wanted them suppressed. Before the CTEA, these materials would have fallen into the public domain within a few years from now. Copyright law has succeeded in silencing what segregationists could not.

University presses and academic journals, the principal places where scholarly works are published, are particularly risk averse, because they have few resources with which to defend themselves against suit. They also have numerous less-risky alternatives to a book or article whose author must rely on fair use. Scholarly publishers and journals have a standard practice of requiring authors to indemnify the publishers against infringement claims, and of requiring proof that they have permission for each visual work or extensive quotation they reproduce. CAA members, for

example, repeatedly report that rights issues are so murky that no publisher will take the risk of relying on fair use of images of artwork.

Bruce Robertson, a former member of the CAA Board of Directors and CAA Vice President and the former chair of the Art History Department at the University of California at Santa Barbara, and Robert Dance, an art dealer, had an all-too typical experience when publishing their book, *Ruth Harriet Louise and Hollywood Glamour Photography* (Univ. of Cal. Press & Santa Barbara Museum of Art 2002). They could not use images from *Vanity Fair* or MGM stills because the publisher could not afford the hundreds of dollars to clear the rights for each, and it would not rely on the fair use defense. These images were about to fall into the public domain prior to the CTEA.[10]

C. The CTEA Results in Extensive Self-Censorship in Violation of the First Amendment.

Fearful of liability, publishers are curtailing authors' speech to avoid any risk of a lawsuit, even though they might ultimately prevail on the merits. For instance, a former book editor for St. Martin's Press, Gordon Van Gelder, edited many books about television and film over twelve years. Over time, that publisher increasingly took the position that, if a photographer could not be located, a photograph could not be published. Thus, the number of published books relying on photographs and film stills, as books on film and television inevitably must do, dropped during his tenure.

[10] By definition, retrospectivity provides no incentive for copyright owners to create the existing works to which it applies; it provides a windfall for subsisting copyrights. Uses of such works by scholars and artists should therefore be considered presumptively more "fair," given that the use would have been lawful but for the CTEA. Even this, however, would be insufficient, particularly for uses of an entire work such as a critical edition, because it is already clear that publishers refuse to take chances on uses that are highly likely to be fair uses.

Creators censor themselves rather than engage in futile efforts to have their work published. Jonathan Veitch, Chair of Humanities at New School University, and Julia Foulkes attempted to create a reader on modernism comprising an anthology of magazine editions from the 1920s and 1930s. They abandoned the project after learning of the CTEA because they determined that clearing rights from the magazines, all of which are defunct and many of which lasted only an issue or two, would, if even possible, consume the time and energy that they instead needed to devote to editing and adding critical commentary to the readings.

Publishers' fears are understandable: It is well-settled that the fair use defense must be evaluated on a case-by-case basis, and publishers must therefore be prepared to defend against a suit each time they rely on fair use. *See, e.g.*, *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994); Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1106–07 (1990) (recognizing fair use's "infinite elasticity").[11] In addition, the burden is on the publisher to prove fair use, as it is an affirmative defense.

It is equally well-settled that such uncertainties are of First Amendment concern because the shadow of the law distorts private speakers' speech. *New York Times Co. v. Sullivan*, 376 U.S. 254, 277-78 (1964). Copyright infringement is a strict liability offense, regardless of a publisher's good-faith belief in its fair use. Strict liability, combined with the substantial burden of sustaining the defense of fair use, is particularly likely to give rise to self-censorship, as *Sullivan* explained in the context of a libel law offering the affirmative defense of truth:

[11] *See also, e.g.*, William W. Fisher III, *Reconstructing the Fair Use Doctrine*, 101 Harv. L. Rev. 1661, 1692–94 (1988); Jessica Litman, *Reforming Information Law in Copyright's Image*, 22 U. Dayton L. Rev. 587, 612 (1997); Lloyd L. Weinreb, *Fair Use*, 4 Fordham L. Rev. 1291 (1999). These analyses confirm *amici*'s members' fears that reliance on fair use is an open invitation to long-term litigation.

> [W]ould-be critics of official conduct may be deterred from voicing their criticism, even though it is believed to be true and even though it is in fact true, because of doubt whether it can be proved in court or fear of the expense of having to do so. They tend to make only statements which "steer far wider of the unlawful zone."

Sullivan, 376 U.S. at 279 (quoting *Speiser v. Randall*, 357 U.S. 513, 526 (1958)).

The costs of self-censorship are identical whether the risk of liability is based on defamation or copyright infringement. Putting the burden on a speaker to rebut a presumption of unlawfulness means that "in every such case the [speaker] must bear the costs of litigation and the risk of a mistaken adverse finding .... This scheme must necessarily chill speech ...." *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 794 (1988). *See also Ashcroft v. Free Speech Coalition*, 535 U.S. ___, 122 S. Ct. 1389, 1404 (2002) ("The Government raises serious constitutional difficulties by seeking to impose on the defendant the burden of proving his speech is not unlawful."); *Florida Star v. B.J.F.*, 491 U.S. 524, 535-36 (1989) (condemning "timidity and self-censorship" that would be caused by "onerous obligation" of sifting materials "to prune out material arguably unlawful for publication") (citation omitted); *Dombrowski v. Pfister*, 380 U.S. 479, 486-87 (1965) (law causing chilling effect is unconstitutional even if defendant is likely to win in the end); *Baggett v. Bullitt*, 377 U.S. 360, 372 (1964) (chilling effect of indefinite prohibitions induces conscientious people to limit themselves to that which is "unquestionably safe").[12]

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[12] Particularly relevant for the types of uses that artists and scholars are likely to make is the copyright principle that the value of the material the copier added to the infringing work is not a defense. *See, e.g., Rogers v. Koons*, 960 F.2d 301, 308 (2d Cir. 1992). Thus, unlike the situation with regard to obscenity or libel, where a work is evaluated as a whole, even a small amount of copying can cause a work to be infringing. This increases the burden copyright imposes on lawful speech. *Cf., e.g., Masson v. New Yorker Magazine, Inc.*, 501 U.S. 496, 516–17 (1991) (holding that First Amendment requires libel law to overlook minor inaccuracies and demands analysis of challenged article as a whole); *Miller v. California*, 413 U.S. 15, 24 (1973) (holding that First Amendment only allows work to be found obscene if, taken as whole, it lacks serious literary, artistic, political or scientific value). The requirement to scrutinize every instance of copying, however limited, magnifies the likelihood of self-censorship by making it more difficult for publishers to determine what is permitted.

The First Amendment recognizes that the risk of self-censorship is more or less tolerable depending on the nature of the interest at stake. For example, the governmental interest in protecting the reputations of private individuals who are not involved in matters of public concern justifies a lower standard for libel than that applicable to public figures. *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974). Although the greater ease of proving libel creates a greater risk of self-censorship of reporting on private individuals than of reporting on public figures, reporting on public figures is justifiably deemed more important. Similarly, the incentive effects of an initial grant of copyright are seen as so pronounced that some self-censorship can be tolerated. As the copyright term increases (bringing declining marginal value to a declining number of works), the costs to speech – particularly for creators, researchers and teachers – far outweigh the benefits.

By definition, the costs of self-censorship often are unknowable. Sometimes, however, the cost is evident. As recounted above, the authors of "Who Built America?" censored their offerings of works in the 1920s and 1930s, forsaking materials that could have, and should have, been part of their history because the publisher refused to rely on fair use. As a result, the federal government's role in the period is overemphasized. This kind of distortion, effected by government regulation but invisible to the public, underlies the First Amendment's concern for self-censorship. The students who look to "Who Built America?" are deprived of the fullness of history. Although copyright in

theory regulates only expression, not ideas, the practical effect of extending the term of older copyrights is to distort speakers' messages.[13]

II. These Harms Are Unjustified Under the Intermediate Scrutiny Test of *Turner*.

A. *Turner* Sets Forth the Appropriate Standard for Evaluating the CTEA.

Copyright restricts some speech in order to promote other speech, expressed in the Constitution as Congress's power to "promote the progress of Science and the Useful Arts." U.S. Const. art. 1 § 8. Copyright law is subject to the First Amendment, however, because its censorial effects could – and do, in this case – substantially outweigh its speech-promoting effects, if any.[14]

The *Turner* cases, which involved content-neutral regulations that suppressed some speech in order to help other kinds of speech, establish the analytic framework for determining whether retrospective extension of the

[13] *Cf. Meyer v. Grant*, 486 U.S. 414, 424 (1988) (First Amendment protects individuals' right "not only to advocate their cause but also to select what they believe to be the most effective means for so doing"); *Cohen v. California*, 403 U.S. 15, 26 (1971) ("[W]e cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.").

[14] Copyright law could not, for example, constitutionally prohibit the use of ideas, as distinct from expression. *See Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985). Copyright scholars have long recognized that First Amendment principles help define the proper limits of copyright. *See, e.g.*, Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180, 1193-96 (1970) (discussing limited term); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970). Whether or not Congress is entitled to any presumption of constitutionality with respect to prospective expansions of the rights or term of copyright, retrospective effects must be examined carefully inasmuch as they inevitably suppress speech without any obvious countervailing incentive for creating works that will be available to the public. In this way, the copyright balance – which promotes the public interest in creation of and access to expression – is skewed sharply against core First Amendment rights.

copyright term violates the First Amendment.[15] In the *Turner* cases, the Court applied intermediate scrutiny, upholding restrictions on speech only after a detailed record had been developed showing that Congress legitimately could have concluded that must-carry regulation of cable providers was necessary to the survival of free broadcast television, and that must-carry contributed to widespread dissemination of information from a multiplicity of sources and preserved fair competition. *Turner II*, 520 U.S. at 189. To guard against the unwarranted suppression of speech, the Court required Congress to show with "substantial evidence" that the harm it is addressing is "real, not merely conjectural," and that regulation would alleviate the identified harm "in a direct and material way" without burdening substantially more speech than necessary. *Turner I*, 512 U.S. at 664-66.

Whether this test is satisfied depends on the facts of each case: "[T]he mere assertion of dysfunction or failure in a speech market, without more, is not sufficient to shield a speech regulation" from First Amendment scrutiny. *Id.* at 640. Furthermore, "[t]hat the Government's asserted interests are important in the abstract does not mean ... that the ... rules will in fact advance those interests." *Id.* at 664.

To satisfy *Turner*, Congress must reasonably have concluded that retrospective term extension furthers "an important or substantial" interest, and that the resulting restriction on speech is no greater than essential. *Id.* at 662 (quoting *United States v. O'Brien*, 391 U.S. 367, 377 (1968)). As to the first of these requirements, the CTEA promotes only the economic interests of the owners of copyright in the very few older works that remain valuable today. As

[15] The analysis set forth in the *Turner* cases has been applied to content-neutral speech regulations beyond the must-carry rules. *See, e.g., United States v. Popa*, 187 F.3d 672 (D.C. Cir. 1999) (applying *Turner* to statute regulating harassing phone calls); *BellSouth Corp. v. Federal Communic. Comm'n*, 144 F.3d 58 (D.C. Cir. 1998) (applying *Turner* to regulation of "electronic publishing" such as disseminating news articles and providing database services).

demonstrated below, this is hardly a substantial interest. As to the second, the CTEA's speech-suppressing effects are far broader than needed to advance the government's purported interests. Retrospective term extension has a vast scope, making its cost to free expression higher and less predictable than were the costs to the limited class of speech at issue in the *Turner* cases. In addition, retrospective term extension cannot be justified by standard incentive theory, which can support prospective increases in copyright rights. Because Congress failed to meet the *Turner* standard of intermediate scrutiny, the judgment below should be reversed.[16]

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[16] Some have argued that, for Petitioners to prevail, all prior term extensions must be deemed unconstitutional, but that claim is mistaken. *Turner* analysis is, by its nature, fact-specific. No class of speech regulations gets an automatic pass or an automatic rejection. The CTEA's retrospective term extension is no exception; invalidating it on its own merits need not affect previous extensions.

First, the CTEA comes at a time where older material is more readily accessible than ever before, where digital preservation is widely available and where dissemination of these works to broad and niche markets alike has never been easier, whether via the Internet or otherwise. Thus, there are many speakers whose speech has been suppressed by the CTEA. There is no reason to assume that past extensions to lesser durations (for example, from 28 to 56 years from publication) had the same speech-inhibiting effects, given the technology of the time and the greater ability to trace ownership over shorter time periods.

Second, the penultimate term extension, in 1976 – the only one still relevant – was part of a comprehensive reform of copyright law decades in the making. This revision, as a whole, substantially increased the incentives to create new works. It also removed the negative effects of formalities such as copyright notice and difficulties with transferring rights that had formerly been traps for the unwary. *Cf. New York Times Co. v. Tasini*, 533 U.S. 483, 494-95 (2001). As part of that larger balance, the extended terms of the 1976 Copyright Act present a very different case.

Finally, First Amendment doctrine itself has been greatly clarified during the latter half of the twentieth century. Ever-expanding copyright laws that go far beyond the initial protections afforded to authors of the Founding era now have evident disruptive effects on the freedom of speech. Because *Turner* analysis looks to the facts of the current situation rather than relying on conceptual categories, it provides a way to evaluate the three justifications offered for the retrospective term extension and the harm it causes in the real world. *See* Section II.B, *infra*.

B. Retrospective Term Extension Does Not Serve a Substantial Governmental Interest.

Based on the legislative record before Congress, there were three possible justifications for retrospective term extension: (1) preservation of older materials; (2) economic benefit to copyright owners who, as owners, might use revenues from term extension to invest in more production; and (3) the need to harmonize the term of copyright with the newly extended European term of copyright.[17] None suffices, in large part because there simply was no evidence to back them up, as *Turner* requires.

1. Retrospective Term Extension Does Not Promote Preservation.

Congress justified retrospective term extension on the ground that it would not be worth the expense for copyright owners to preserve old motion pictures if they entered the public domain. Congress lacked any evidence, however, that any number of older works had sufficient present value that twenty more years of copyright would tip the economic balance in favor of preservation.[18]

In fact, the only specific evidence came from independent archives that own copies of works and were preserving public domain works. *See, e.g., 1995 Hearing, supra*, at 154 (statement of Larry Urbanski, Chairman, American Film Heritage Ass'n) ("Films from the 1920's could contain as much as 75 percent of motion picture works no longer owned by anyone, with no traceable lineage, called Orphan works.... [that] ... will be abandoned because public

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[17] *See* S. Rep. No. 104-315 (July 10, 1996).

[18] *See Nixon v. Shrink Missouri Gov't PAC*, 528 U.S. 377, 392 (2000) ("We have never accepted mere conjecture as adequate to carry a First Amendment burden ...."); *Turner I*, 512 U.S. at 664 (Congress must do more than "simply 'posit the existence of the disease sought to be cured'") (citation omitted); *Time Warner Entertainment Co. v. Federal Communic. Comm'n*, 240 F.3d 1126, 1132 (D.C. Cir. 2001) (if substantial evidence justifying speech restriction existed, "one would expect the [Congress] to be able to point to examples").

domain allowed the economic incentive to preserve them."); *id.* at 160-61 (statement of John Belton, Society for Cinema Studies) (listing public domain works preserved by non-copyright owners and explaining that, of surviving older films, only a small percentage have commercial value).[19]

When it came to preservation, Congress failed to make "reasonable inferences based on substantial evidence" that retrospective term extension was justified. *Id.* at 666.

2. Congress Had No Evidence That Retrospective Term Extension Operates as an Incentive to Create New Speech.

Copyright owners asserted to Congress that preserving their copyright monopoly for an additional twenty years would give them more money to invest in producing more works, encouraging widespread availability of diverse types of speech. This argument fails on the lack of evidence and, indeed, on the basis of logic and common experience.

Congress made no findings that the motion picture, software or any other content industry was in danger. To the contrary, as every witness emphasized, the United States copyright industries are the most successful and influential in the world. No one testified that the economic returns from exploiting the few older works that still have value for twenty more years would make a noticeable difference in

[19] The problems with reserving to copyright owners the sole right to preserve are not limited to motion pictures. The 1911 edition of the *Encyclopaedia Britannica*, for example, which "broke new ground by having experts in each field prepare its articles" and is currently of historical interest, is available on-line only through the efforts of Byron Reese, who scanned the 29 volumes using customized software over two years, at a cost of $200,000, because of his personal interest in it. Pamela LiCalzi O'Connell, *Online Diary*, N.Y. TIMES, Apr. 11, 2002. Encyclopaedia Britannica itself does not make older editions available because there is no commercial market for them. *Id.* (quoting spokesman's statement that "When it comes to creating products that people will actually buy, we find that up-to-date information is what they want.").

investment.[20] There is no substantial governmental interest sufficient to survive intermediate scrutiny in marginally improving the condition of a few members of a thriving industry.[21] The Court has never recognized a similar interest in subsidizing a particular class of private persons as a justification for speech regulations, and to do so here would make the concept of substantial interest meaningless.

Copyright owners justified this subsidy by asserting that works in the public domain are in the dustbin of history, of no benefit to the public because no one has a proprietary interest in them. *See, e.g., 1995 Hearing, supra*, at 41 (statement of Jack Valenti, President, Motion Picture Ass'n of America). ("[P]ublic domain means nobody really cares because nobody owns it."). The First Amendment, however, teaches that speech is not just an investment vehicle: People have reasons to speak beyond maximizing their wealth and their speech has value beyond the economic value to the owner. Likewise, copyright law itself recognizes that the public domain contains the accumulated knowledge of the ages and is a vital source of inspiration for new works.

The denigration of the public domain also ignores basic economic principles that competition to produce goods drives prices down and encourages quality improvements such as, in this case, new illustrations or critical commentary. *See Nixon*, 528 U.S. at 391, 394 ("more

[20] The proponents asserted that new technology enables many works to retain value longer than they used to, but that is no substitute for evidence of value at term's end. If new technology increases the average work's lifetime from five to fifteen years, term extension is still useless to most copyright owners. The focus on computer software highlights the dubious reasoning employed to justify term extension. *See, e.g.*, S. Rep. No. 104-315 (July 10, 1996) (stating that foreign application of extended term was particularly important because 70% of software worldwide is American-produced). Software has a shelf-life of a few years, not nearly a hundred years. It is vanishingly unlikely that software copyright owners could ever benefit from term extension.

[21] *See Turner I*, 512 U.S. at 667 (speech suppression unjustified absent evidence of broadcasters' "serious risk of financial difficulty").

extensive evidentiary documentation" is required where justification for regulation is novel or implausible). The record contains no assessment of the productivity of public domain publishers versus copyright owners of works of the same or similar vintage.[22] As Senator Hank Brown pointed out, the year after Willa Cather's *My Antonia* went into the public domain, seven new editions appeared with widely varying prices, and literary critics agree that this is a recurring pattern. *See* Minority Views of Sen. Brown, S. Rep. No. 104-315 (July 10, 1996); John Sutherland, *The Great Copyright Disaster*, LONDON REV. OF BOOKS, Jan. 12, 1995, at 3 ("[G]ood editions of great works coincide with the end of copyright protection.") (quoted in *1995 Hearing*, *supra*, at 76 (statement of Peter Jaszi, Professor of Law, Washington College of Law, The American University [hereinafter Jaszi]).[23]

Regardless of the CTEA, copyright law encourages copyright owners to add value to works in the public domain. The author of any work lawfully derived from another work obtains a copyright in the original elements of the new work. For example, a new film of *Hamlet* or *The Age of Innocence* will be protected by copyright. Thus, extending the term of copyright protection for the original is entirely unnecessary to provide the former copyright owner,

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[22] Owners of recent works are more likely to make money simply because recent works are on average much more popular.

[23] Professor Jaszi further explained:

> [A] visit to any large bookstore quickly reveals that publishers do compete to offer new editions of popular public domain works – from Sherlock Holmes stories to children's classics like "The Velveteen Rabbit" – often competing as well to include "value added" (such as new introductions, notes or illustrations) which will distinguish particular reprint editions and permit the assertion of copyright in them as "derivative works." The most vivid instance of this last phenomenon is that of Shakespeare's works, with literally dozens of editions available in print, catering to the preferences of every consumer group, from the ultra-scholarly to the price-conscious.

1995 Hearing, *supra*, at 73 (Jaszi).

or anyone else, an incentive to create a new work. *See id.* at 72 (Jaszi); *id.* at 82 n.5 (Karjala *House Statement*).[24] As a result, there is no substantial government interest in subsidizing this particular type of speaker, nor any evidence that the "subsidy" would actually produce new speech.

The Register of Copyrights' evaluation of the evidence before Congress, based on the Copyright Office's extended study of the issue, could not be clearer:

> One must also factor in what will be the cost of extending the term in the United States since this is the largest market for U.S. works. Unfortunately, there are *no meaningful statistics* to assist in determining the cost of extending the term and the benefits to be gained. Thus, *on a pure economic analysis, at this point it would be difficult to support* [term extension].

Id. at 22 (Peters) (emphasis added); *see also id.* at 79, 80-81 (Karjala *House Statement*) (stressing absence of empirical data and contrary evidence).

3. Harmonization of Copyright Terms With the European Union Serves No Substantial Interest.

The CTEA extended the term in the United States to match the European Union's term of life of the author plus seventy years,[25] although many other nations retain shorter terms. As Petitioners' Brief explains in detail, the extension of copyright term neither constitutes "harmonization" in the

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[24] One might argue (though no one did) that competing works based on public domain originals would harm former copyright owners. This is no "harm" at all: It is the marketplace of ideas in action. A more attractive or better-annotated edition of a public domain work enhances speech overall. In any event, Congress had no evidence on this point. Disney's *Beauty and the Beast* and Cocteau's *Beauty and the Beast* derive from the same tale, but it would be hard to call them substitutes. *Cf. Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1274-75 (11th Cir. 2001) (finding no evidence that unauthorized derivative work based on *Gone With the Wind* would harm market for authorized derivative works).

[25] *See* Council Directive 93/98, 1993 O.J. (L 290).

sense of conforming to a normative international copyright term, nor furthers any consistent policy of letting other countries dictate United States copyright law.[26] Imitation for imitation's sake is not a substantial governmental interest, especially because our Nation's copyright law must conform to our cherished constitutional principles of free expression.

"Harmonization" is simply a reiteration of the interest in transferring more (foreign) money to owners of a few successful older copyrighted works, as the congressional findings made clear.[27] This is like no type of substantial interest ever recognized by the Court. It is also a far cry from improving the balance of trade. The overwhelming majority of United States and foreign works in circulation, here and overseas, are recent works. There is no reason to think this will change over time. Congress therefore lacked any evidence that works near the end of their term produce any significant portion of international royalties. *See* Minority Views of Sen. Kohl, S. Rep. No. 104-315 (July 10, 1996); *1995 Hearing*, *supra*, at 148 (Karjala). In fact, the only testimony on point was that extending the term for older United States works, created when Europe – and not

[26] Congress was well aware that United States law, including provisions enacted concurrently with retrospective term extension, deviated from international copyright norms. *See, e.g., Hearing on Music Licensing in Restaurants and Retail and Other Establishments Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 105th Cong. 44-45 (July 17, 1997) (statement of Bruce Lehman, Assistant Comm'r of Patents and Trademarks [hereinafter Lehman]) (discussing conflict between international law and performance rights exception for small businesses); *Copyright Hearings on Pre-1978 Distribution of Recordings Containing Musical Compositions; Copyright Term Extension; and Copyright Per Program Licenses Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 105th Cong. 110 (June 27, 1997) (statement of Jerome Reichman, Professor, Vanderbilt School of Law) (discussing divergence between CTEA and European law).

[27] *See, e.g.*, S. Rep. No. 104-315 (July 10, 1996) (harmonization will "ensure the greatest possible exploitation of the commercial value of these works in world markets for the benefit of U.S. copyright owners").

the United States – was the leading exporter of content, may actually lead to a net transfer of royalties from the United States to Europe. *See id.* at 88 (Karjala *House Statement*).

C. Retrospective Term Extension Fails the *Turner* Test Because It Is Not Narrowly Tailored to Congress's Goals.

The CTEA extends the copyright term across the board, though far less restrictive alternatives exist. For the many works with no present economic value, retrospective term extension provides no benefit. An across-the-board term extension unnecessarily blocks would-be speakers from using those works. By definition, it is substantially broader than necessary.[28]

All of Congress's asserted aims could have been accomplished by inhibiting a much smaller amount of speech: Congress could have enacted an extension that only applied to works that still had economic value to the creators. Creators who were still interested in exploiting such works could simply file a notice with the Register of Copyrights in a database that could be searched by anyone. Otherwise, works would pass into the public domain. This

[28] The CTEA did add a new section, 17 U.S.C. § 108(h), which provides an extremely limited exception for nonprofit libraries and archives to reproduce, distribute, display or perform a work in the last 20 years of its term under certain circumstances, including "reasonable investigation" into the work's commercial availability.

Most significantly, section 108(h)(3) expressly provides that the new exception does not apply to any subsequent users, including artists wishing to incorporate an image into a new work and scholars wishing to reproduce images in furtherance of their arguments. The exception does not in any way mitigate the harms to the speech of the people for whom archives and libraries exist. Like a regulation requiring speakers to speak in a parking lot and not in the town square, section 108(h) purports to protect speech rights while making them hard to exercise.

In addition, VRA and CCUMC members who are archivists of slides, photographs, film, video, digital images and other media have an impossible task in "reasonable investigation." There are no equivalents to Books in Print, or any other reliable sources, setting forth the availability of images and motion pictures scattered throughout the nation.

regime would emulate the notification provisions already in place for the Uruguay Round Agreements Act's restoration of copyright, 17 U.S.C. § 104A(e) (1994), which require copyright owners to give notice, either publicly or directly to affected parties, in order to cut off others' use of certain foreign works that had fallen into the public domain in the United States. It would also track 17 U.S.C. § 108(h)(2)(c), added by the CTEA as a partial exemption for libraries and archives, which allows copyright owners to provide notice in order to make the exemption inapplicable.

This type of opt-in regime, now established in discrete sections of the copyright law, would allow copyright owners to assert rights under the Copyright Act based on the economic calculation that a particular work's copyright was still valuable. It would preclude any suppression of speech based on untraceable works or works whose present value is historical and cultural.[29] The availability of this alternative demonstrates that the CTEA's retrospective term extension is not narrowly tailored to the interests sought to be protected. *See Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 122 n.* (1991) ("A regulation is not 'narrowly tailored' ... where, as here 'a substantial portion of the burden on speech does not serve to advance [Congress's] goals.'") (citation omitted); *Ward v. Rock Against Racism*, 491 U.S. 781, 799 n.7 (1989) ("the essence of narrow tailoring" is "focus[ing] on the source of evils the [Government] seeks to eliminate ... and eliminat[ing] them without at the same time banning or significantly restricting a substantial quantity of speech that does not create the same evils").[30]

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[29] It would not avoid problems associated with artists' and scholars' inabilities to make use of works as to which notice was given, but it would at least somewhat contain the damage.

[30] As to significant classes of works, moreover, retrospective term extension is not at all tailored to advance the purported interest in harmonization. The United States term for sound recordings, for example, was already longer than the European term before the CTEA. *See 1995 Hearing*, *supra*, at 25 (Lehman).

CONCLUSION

Retrospective term extension suppresses and distorts many speakers' messages, whether artistic, scholarly or pedagogical, inhibits the creation of new works based on old ones and deprives the public of access to older works of historical and cultural interest. No justification offered by Congress is based on substantial evidence, nor outweighs these very palpable harms.

For the foregoing reasons, the judgment of the Court of Appeals should be reversed.

Respectfully submitted,

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